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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,676	07/07/2006	Masaichi Hasegawa	TC00007	4699

7590 08/11/2009  
Glaxosmithkline  
Corporate Intellectual Property UW2220  
P O Box 1539  
King of Prussia, PA 19406-0939

EXAMINER
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DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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08/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**DETAILED ACTION*****Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4 and 7, drawn to compounds and pharmaceutical compositions wherein M

is given by the formula



and Y is

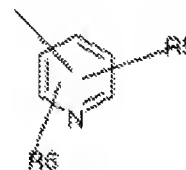


Group II, claim(s) 1-4 and 7, drawn to compounds and compositions of the formula given in

claim 1, wherein M is

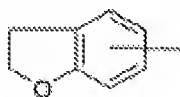


and Y is a



Group III, claim(s) 1-4 and 7, drawn to compounds and compositions of the formula given in

claim 1 wherein M is

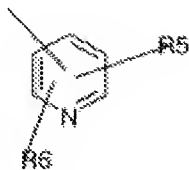


and Y is



Group IV, claim(s) 1-4 and 7, drawn to compounds and compositions of the formula given in claim 1, wherein M is given by

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and Y is

Group V, claim(s) 1-4 and 7 drawn to compounds and compositions of the formula given in



claim 1 wherein M is given by

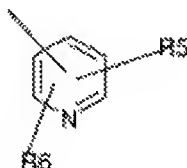
and Y is given by .



Group VI, claim(s) 1-4 and 7, drawn to compounds and compositions of the formula given in claim 1 wherein M is given by



and Y is given by



Groups VII-XII, claim(s) 5,6 drawn to a method of treating using the compounds of one of the groups 1-VI above.

The inventions listed as Groups I-IV and VII-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

(f) Markush Practice. The situation involving the so-called •Markush practice• wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, **and**

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(ii) In paragraph (f)(i)(B)(1), above, the words •significant structural element is shared by all of the alternatives• refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally

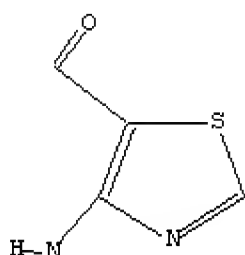
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distinctive portion in view of the existing prior art. The structural element may be a single component or a combination of individual components linked to-gether.

The different M, Y, X substituents have so many variables with the heterocyclic and non-hetero groupings, they have different bonding and properties, and have achieved a different status in the art, and is burdensome to search and hence are objected to as being drawn to an improper Markush group on the grounds of lack of a common nucleus. The terms M, X, Y are so broad in scope that a prior art reference anticipating the claims with respect to one member under 35 USC 102(b) would not render obvious the same claims under 35 USC 103a with respect to another member.

When a preliminary search was done on the core it gave numerous iterations, which indicated that applicants core is not a contribution over the prior art.

L1 STR



Structure attributes must be viewed using STN Express query preparation

=> s 11

SAMPLE SEARCH INITIATED 15:27:04 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 531 TO ITERATE

100.0% PROCESSED 531 ITERATIONS 50 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE \*\*COMPLETE\*\*

BATCH \*\*COMPLETE\*\*

PROJECTED ITERATIONS: 9238 TO 12002

An attempt was made to call Edward Gimmi on 8/5/09 to request an oral election to the above restriction requirement, but the examiner was unable to do so.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102,

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103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

August 5, 2009.